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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,477	11/13/2000	Isabelle Preuilh	2365-23	4547

7590

05/14/2002

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
1617	10

DATE MAILED: 05/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/709,477

Applicant(s)

PREUILH ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-33 and 35-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-33 and 35-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 31-33 and 35-61 are pending. The Amendment filed April 3, 2002 cancelled claim 34 and amended claims 32-33, 40, 42, 50-53, and 59.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed April 3, 2002 (Paper No. 9) to the rejection of claims 31-61 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Applicant's amendment filed April 3, 2002 (Paper No. 9) is sufficient to overcome the objections to the specification, and is sufficient-in-part to overcome the 35 USC 112 rejection. See below for details.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

112 Rejection Maintained

The rejection of claims 33, 40, 50 and 51 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed October 4, 2001, Paper No. 8, and those found below.

- (i) The rejection of claims 50 and 51 is maintained, as the ratio is still confusing.
- (ii) The term "derivative" in claim 40 is still rejected, as it is not clear what compounds are encompassed by the phrase "a derivative of an aliphatic secondary or tertiary amine in which the aliphatic radical is a linear or branched chain comprising 8 to 22 carbon atoms and comprising at least one water-solubilizing anionic group". Furthermore, the phrase "water-solubilizing anionic group" is vague and indefinite, as it is not clear what compounds this phrase

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is referring to. The specification does not define these phrases and one of ordinary skill in the art would not be apprised of them.

(iii) While Applicant has overcome the rejection of the phrase “derivative” in claim 33, Applicant’s amendment to the claim is confusing. Specifically the Markush language is confusing, as the Markush group contains two “ands”. As a result, the Markush group is not clear.

103 Rejection Maintained

The rejection of claims 31-33 and 35-61 are under 35 U.S.C. 103(a) as being unpatentable over Cameron (4,722,837) in view of Casmer et al. (3,984,544) and Klingman (5,998,395) in further view of Cauwet (5,661,118) is MAINTAINED for the reasons set forth in the Office Action mailed October 3, 2001, Paper No. 8, and those found below.

Applicant argues “Cameron discloses the use of one detergent as above mentioned. Only one anionic surfactant. . .is contained in Examples I and II, and no betaine nor any other amphoteric surfactant are exemplified. Consequently, this document does not teach the combination of an anionic surfactant and an amphoteric surfactant as mentioned by the Examiner”. This argument is not persuasive. The Examiner respectfully points out that a reference is not limited to its working examples, but must be evaluate for what it teaches those of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). In re Chapman, 357 F.2d 418, 148 USPQ 711 (CCPA 1966). In Col. 2, lines 21-33, the reference teaches the combination of a laureth sulfate salt (anionic surfactant) and a betaine (an amphoteric surfactant).

Applicant argues “Casmer discloses novel active principles for treating acne vulgaris (and not scalp disorders)”. This argument is not persuasive, as the intended use of the instant

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composition does not bear patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant argues “Casmer et al. never suggest a foaming composition. . .Klingman et al. never suggest a foaming composition” This argument is not persuasive. First, the Examiner respectfully points out that Casmer et al. and Klingman et al. were not relied upon for their teachings of a foaming composition. Second, the recitation “foaming” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues, “There was then absolutely no motivation for one of ordinary skill in the art to combine Cameron et al. relating to a medicated shampoo for treating scalp disorders with Casmer et al. and Klingman et al. relating to the treatment of skin diseases such as acne”. This argument is not persuasive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Klingman et al. and Casmer et al.

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with the invention of Cameron and obtain a composition comprising both a corticosteroid and a retinoid because a) all three references are directed to treating dermatological inflammatory disorders relating to sebaceous glands, with topical compositions; b) Cameron teaches the applications of corticosteroids in his composition and Klingman et al. teach that combining corticosteroids and retinoids in compositions that treat inflammatory dermatitis results in a synergistic effect.

Regarding Cauwet, Applicant argues, "one of ordinary skill in the art had absolutely no motivation to combine the reference relating to a disentangling shampoo (Cauwet) with Klingman and Casmer relating to the treatment of skin diseases. . .with Cameron relating to a medicated shampoo containing hydrocortisone for treating scalp disorders". This argument is not persuasive. Again, the Examiner respectfully points out that a reference is not limited to its working examples. The Examiner respectfully directs Applicant to claim 1 of Cauwet, wherein his invention is directed to the hair, skin, or hair and skin. Furthermore, Cauwet teaches that his composition can contain anti-seborrhoeic agents, wherein anti-seborrhoeic agents treat dermatological inflammatory disorders relating to sebaceous glands. Hence, it would have been obvious to combine the teachings of Cauwet with that of the combined references.

Unexpected Results

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing"

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In re Lohr, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, there are no unexpected results.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
May 6, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200